

**Remarks**

This communication is considered fully responsive to the first Office Action mailed November 15, 2004. Claims 1-24 were examined. Claims 1-24 stand rejected. Claims 1, 10, and 22-23 are amended. No claims are canceled. No new claims have been added. Reexamination and reconsideration of claims 1-24 are respectfully requested.

**Information Disclosure Statement**

Applicant draws the examiner's attention to the supplemental information disclosure statement filed on December 13, 2004, and respectfully requests consideration of the references cited therein.

**Claim Rejections - 35 U.S.C. 112**

The Office Action rejected claims 22 and 23 under 35 U.S.C. 112, second paragraph, as improperly depending from claim 20. Claims 22 and 23 are amended to depend from claim 21. Applicant appreciates the examiner noting this typographical error in the original claims.

**Claim Rejections - 35 U.S.C. 103(a)**

The Office Action rejected claims 1, 2, 4, and 6-8 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,181,704 to Drottar, et al. (hereinafter referred to as "Drottar") in view of U.S. Patent No. 6,324,178 to Lo, et al. (hereinafter referred to as "Lo") and further in view of a publication

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entitled "Bluetooth Revealed" by Brent Miller (2000) (hereinafter referred to as "Miller"). Applicant respectfully traverses this rejection.

Amended claim 1 positively recites "a packetizer . . . a communication controller . . . and a transceiver . . . to manage memory resources for the electronic device." None of the cited references teach or suggest each of these recitations. Instead, the Office Action resorts to a piecemeal reconstruction of Applicant's claim 1, using Lo to show "a packetizer," Miller to show "a communication controller," and Drottar to show "a transceiver." But none of these references teach or suggest the claimed combination to manage memory resources for an electronic device.

If identification of every recitation in the prior art were sufficient to negate patentability, very few patents would ever issue since many inventions are combinations of known elements. See *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865, 870 (Fed. Cir. 1983). Instead, there must be some motivation, suggestion or teaching of the desirability of making the claimed combination in order to establish a *prima facie* case of obviousness. MPEP at §2143.01. But the Office Action failed to provide any such motivation for combining the references to reject claim 1.

In what appears to be an attempt to provide some motivation, the Office Action concluded that Drottar and Lo "both deal with transferring data to a remote device" and that Drottar and Miller "both deal with the transfer of data in packets to a remote device." However, simply concluding that the references pertain to the same general technology as the other references (i.e., electronic communications) is not sufficient to show motivation for combining the

references. In addition, none of the references pertain to claimed invention (i.e., managing memory resources for an electronic device).

The Office Action also relies on Lo (col. 6, lines 25-30) to conclude that providing "a data packetizer increases the efficiency of transmitting data from a memory location because the data does not have to be saved as in packet format prior to transmission through the network." However, the citation in Lo does not support the examiner's conclusion. Instead, Lo is explaining that the data payload section does not need to be copied "from one memory space to another memory space during the assembly of a new data packet compatible with the second communication bus" because pointers may be used to locate the data payload section in the original memory space. Id. This section of Lo does not teach or suggest the recitations of claim 1.

In addition, the Office Action relies on Miller in concluding that establishing "communications between devices opportunistically would allow establishing wireless communications with a suitable remote storage device simply by approaching the device." This statement is nothing more than an observation made in hindsight based on teachings of the Applicant's invention. Drottar describes a very specific method of transmitting data in a network so that data is not lost during the transmission. The mere fact that it *might* be employed in the wireless network described by Miller does not provide the requisite motivation for combining these references to show the recitations of claim 1.

For at least the foregoing reasons claim 1 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2, 4, and 6-8 depend from claim 1, which is believed to be allowable. Therefore, claims 2, 4, and 6-8 are also believed to be allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claims 2, 4, and 6-8 is respectfully requested.

In addition, claim 2 further recites "a memory controller for singly deleting said digital data that corresponds to said transmitted copies of said packets." The Office Action relies on Drottar (Col. 7, lines 40-44) as disclosing this recitation. However, the cited passage in Drottar states that the send queue "must wait for an ACK for those packets before it can reuse those buffers." There is no teaching of a memory controller. The auxiliary data structures in Drottar (i.e., the "send queue" and the "buffer") can not be properly construed as a memory controller. Nor can reusing an auxiliary data structure (i.e., the buffer) be properly construed as singlly deleting digital data from the electronic device. Withdrawal of the rejection of claim 2 is requested for at least these reasons.

Furthermore, the arguments against combining the cited references set forth above with regard to claim 1 also apply to the combination of these same references to reject claims 4 and 6.

The Office Action rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, and Miller, and further in view of U.S. Patent

No. 6,567, 983 to Shiimori (hereinafter referred to as "Shiimori"). Applicant respectfully traverses this rejection.

Claim 5 depends from claim 1, which is believed to be allowable, and therefore claim 5 is also believed to be allowable for at least the same reasons as claim 1.

In addition, the Office Action fails to provide any motivation for combining the teachings of Shiimori with the teachings of Drottar, Lo, and Miller. The Office Action relies on Shiimori (col. 13, lines 32-47) to conclude that saving a reduced representation of the digital data "would allow displaying representation of the images to the user to select files to be transferred or printed while conserving the limited memory available on the client device." This assertion is not supported by Shiimori. Although Shiimori describes using a thumbnail image to select an electronic album, the citation does not support the examiner's bare assertion that it conserves limited memory available on the client device.

Withdrawal of the rejection of claim 5 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, and Miller, and further in view of U.S. Patent No. 6,784,925 to Tomat, et al. (hereinafter referred to as "Tomat"). Applicant respectfully traverses this rejection.

Claim 11 depends from claim 1, which is believed to be allowable, and therefore claim 11 is also believed to be allowable for at least the same reasons as claim 1.

In addition, claim 11 positively recites “[t]he electronic device of claim 1 further comprising: a file manager . . . .” The Office Action concluded that “Tomat teaches a file manager for selecting digital data to be transmitted from the device.” However, Tomat discloses software for a personal computer that can be used to manage files stored on a digital camera. Tomat fails to disclose the electronic device comprising a file manager.

Furthermore, the Office Action also fails to provide any motivation for combining the teachings of Tomat with the teachings of Drottar, Lo, and Miller. The Office Action merely concludes that providing “a file manager for selecting data for transmission would allow users to elect which data is to be transmitted and deleted from the electronic device.” The examiner’s assertion is a hindsight observation based on the teachings of Applicant’s invention, and is not taught or suggested by Tomat.

Withdrawal of the rejection of claim 11 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claims 3, 12-15, 17, 18, 20, 21, 23, and 24 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, and Miller, and further in view of U.S. Patent No. 6,798,533 to Tipirneni (hereinafter referred to as “Tipirneni”). Applicant respectfully traverses this rejection.

Claim 3 depends from claim 1, which is believed to be allowable, and therefore claim 3 is also believed to be allowable for at least the same reasons as claim 1.

In addition, claim 3 positively recites “an interactive memory controller wherein a user selects ones of said digital data corresponding to said

transmitted copies of said packets for deletion" (emphasis added). The Office Action cites to Tipirneni as disclosing this recitation. Although Tipirneni discloses a Clear Log Command to delete display entries from the Log Field (col. 7, lines 19-22), Tipirneni fails to disclose the user selecting digital data for deletion.

Furthermore, the Office Action also fails to provide any motivation for combining the teachings of Tipirneni with the teachings of Drottar, Lo, and Miller. The Office Action concludes that "allowing the user to interactively select digital data for deletion after the data has been transmitted would allow the user to verify that transmission was problem free before the data on the electronic device was deleted." This statement is nothing more than a bare assertion and is not supported by Tipirneni.

Withdrawal of the rejection of claim 3 is respectfully requested for at least the foregoing reasons.

With regard to the rejection of claim 12, the arguments against combining Drottar, Lo, Miller, and Tipirneni, set forth above with regard to claims 1 and 3 also apply to the combination of these references to reject claim 12.

Furthermore, claim 12 positively recites "a method for managing memory resources on an electronic device." The cited references fail to teach or suggest at least this recitation, as discussed above for claim 1.

Withdrawal of the rejection of claim 12 is respectfully requested for at least the foregoing reasons.

Claims 13-15, 17, 18, and 20 depend from claim 12, which is believed to be allowable. Therefore, claims 13-15, 17, 18, and 20 are also believed to be allowable for at least the same reasons as claim 12. Withdrawal of the rejection of claims 13-15, 17, 18, and 20 is respectfully requested.

In addition, the arguments against combining Drottar, Lo, Miller, and Tipirneni, set forth above with regard to claims 1 and 3 also apply to the combination of these references to reject claims 14-15, 17, and 18. Withdrawal of the rejection of claims 14-15, 17, and 18 is requested for at least these reasons.

Claim 21 positively recites "a system of managing memory resources on an electronic device." The cited references fail to teach or suggest at least this recitation, as discussed above for claim 1.

In addition, the arguments against combining Drottar, Lo, Miller, and Tipirneni, set forth above with regard to claims 1 and 3 also apply to the combination of these references to reject claim 21.

Withdrawal of the rejection of claim 21 is respectfully requested for at least the foregoing reasons.

Claims 23-24 depend from claim 21, which is believed to be allowable. Therefore, claims 23-24 are also believed to be allowable for at least the same reasons as claim 21.

In addition, the arguments against combining Drottar, Lo, Miller, and Tipirneni, set forth above with regard to claims 1 and 3 also apply to the combination of these references to reject claim 23.

Withdrawal of the rejection of claims 23-24 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claims 9-10 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, and Miller, and further in view of Official Notice by the Examiner. Applicant respectfully traverses this rejection.

Claims 9-10 depend from claim 1, which is believed to be allowable. Therefore, claims 9-10 are also believed to be allowable for at least the same reasons as claim 1.

In addition, the Office Action improperly relies on Official Notice in rejecting claims 9-10. The Office Action states that "Drottar fails to teach that the electronic device further comprises a switch for deactivating the transceiver and that the switch is selectable by the user." Applicant agrees with this admission. The Office Action, however, attempts to cure this deficiency with Official Notice. Applicant respectfully traverses.

Per MPEP § 2144.03, Applicant challenges the factual assertion as not properly officially noticed or not properly based upon common knowledge. As such, Applicant asks the Examiner to provide adequate **documentary evidence**.

Applicant contends that the noticed fact is not considered common knowledge or well-known in the art. For example, it would not have been well-known to provide "a switch for deactivating said transceiver" (claim 9) and "said switch is selectable by a user" (claim 10) with the teachings of Drottar, Lo, or Miller. Neither Drottar nor Lo include a communication controller for "opportunistically establishing communication" and therefore would not

benefit from such a switch. Although Miller discusses opportunistic communication and may benefit from such a switch, the fact that Miller fails to disclose such a switch is evidence that it would not be well-known.

Furthermore, the facts relied on for official notice may only serve to 'fill the gaps' which might exist in the evidentiary showing - not comprise the principle evidence upon which a rejection is based. Id. The Office Action erroneously relied on official notice as the only evidence for rejecting the recitations of claims 9-10.

In light of Applicant's traversal, Applicant respectfully asks the Examiner to produce authority (in the form of documentary evidence) for the alleged notice. Otherwise, withdrawal of the rejection of claims 9-10 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claim 16 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, and Miller, and further in view of U.S. Patent 6,496,477 to Perkins (hereinafter referred to as "Perkins"). Applicant respectfully traverses this rejection.

Claim 16 depends from claim 12, which is believed to be allowable. Therefore, claim 16 is also believed to be allowable for at least the same reasons as claim 12.

In addition, the arguments against combining Drottar, Lo, and Miller, set forth above with regard to claim 1 also apply to the combination of these references to reject claim 16. The Office Action also fails to provide any motivation for combining the teachings of Perkins with Drottar, Lo, and Miller beyond the bare assertion that "transmitting additional packet copies via a

neighboring connection would increase the reliability of reception at the packet at the final destination by providing diverse analog and digital paths for the data packets."

Withdrawal of the rejection of claim 16 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, Miller, Shiimori, and further in view of a publication entitled "Image Thumbnailing Whitepaper" by R. Kieffer of Alodar Systems, Inc. (1998) (hereinafter referred to as "Kieffer"). Applicant respectfully traverses this rejection.

Claim 19 depends from claim 12, which is believed to be allowable. Therefore, claim 19 is also believed to be allowable for at least the same reasons as claim 12.

In addition, claim 19 positively recites "partially reassembling said packets at said electronic device into a thumbnail version of said data stored on said electronic device prior to said deleting step" (emphasis added). The Office Action relies on Shiimori and Kieffer as disclosing these recitations. However, Shiimori and Kieffer both fail to disclose partially reassembling packets at an electronic device prior to deleting the electronic data.

Furthermore, the Office Action has failed to show any motivation for combining Shiimori with the teachings of Drottar, Lo, and Miller, as discussed above for claim 5. The Office Action also fails to show any motivation for combining Kieffer with the teachings of Drottar, Lo, Miller, and Shiimori. The Office Action merely states that Kieffer "allows reducing the amount of storage

to display an image using limited amounts of computing resources." However, this bare assertion is not supported by the citation to Kieffer.

Withdrawal of the rejection of claim 19 is respectfully requested for at least the foregoing reasons.

The Office Action rejected claim 22 under 35 U.S.C. 103(a) as being unpatentable over Drottar, Lo, Tipirneni, and Shiimori. Applicant respectfully traverses this rejection.

Claim 22 depends from claim 21, which is believed to be allowable. Therefore, claim 22 is also believed to be allowable for at least the same reasons as claim 21.

In addition, the arguments against combining the teachings of Drottar, Lo, Tipirneni, and Shiimori, set forth above with regard to claims 1, 3, and 5 also apply to the combination of these references to reject claim 22.

Withdrawal of the rejection of claim 22 is respectfully requested for at least the foregoing reasons.

**Conclusion**

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

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